

REMARKS

Claims 1-20 are pending in this application. Claims 1, 8 and 13 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application.

Interview Summary

On 17 November 2005 and 18 November 2005, S. S. Sahota (Reg. No. 47,051) talked via telephone with Examiner C. S. Park. The 35USC§102 and 35USC§103 rejections of independent claims were discussed, in particular with regard to the reference Yoshida et al. (U.S. Patent No. 6,449,063) as applied for example to claim 1. The Examiner suggested amending the claim to include transmitting the stored document data in the same order as the received data output order to further clarify the claim. The Examiner also acknowledged entry of the amendment filed on 18 August 2005.

I. Claim Rejections - 35 USC § 102

A. Claims 1 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshida et al. U.S. Patent No. 6,449,063 (hereinafter Yoshida). The Applicant respectfully traverses.

No claim is anticipated under 35 U.S.C. §102 (b) unless all of the elements are found in exactly the same situation and united in the same way in a single prior art reference. As mentioned

in the MPEP §2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as complete detail as is contained in the patent claim. *Id.*, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.

1. With respect to claim 1, in paper no. 20050831, the Examiner stated that Yoshida teaches requiring and receiving said data output order by said facsimile transmitting part from said facsimile receiving part after the telephone number of said facsimile receiving part is dialed (S88).

However, the data output order is not taught or suggested to be sent from the transmitting part to the receiving part after dialing because Yoshida's order is the same whether there is a single side printing or double sided printing. Its only when there is an error in the printing that a blank page is avoided on a side. The order itself is not changed, but rather when there is an error, the back side is not printed on. As mentioned on col. 10, lines 54-57, always retransmitting from the front side at the same time of transmission of the both side document sheet as an error re-transmission. Yoshida helps in retransmitting of a transmission with an error without concern for the collation of the print.

Therefore, the both side and single sided printing is not actually a setting of the printing order

itself as mentioned in col. 10, lines 41-45, when there is a both side print, it is sequentially transmitted and the one side document would be printed the same way, but not printed on the back side. The actual printing order is not affected, rather in retransmission Yoshida does not force the reverse side to be printed on the front side. The reverse page is kept on the reverse page in the retransmission while the front page is kept on the retransmission. The present invention, however concerns the actual output order which is sent by the receiving part and received by the transmitting part after dialing.

In Yoshida, the output order remains the same which is still sequential.

2. In addition, the present invention states that the stored document is transmitted according to the received data output order. Yoshida does not disclose transmitting the stored document data in the same order as the received data output order as seen in the amended claim 1. The data that is transmitted by Yoshida is not varied according to the order received, but when retransmitting, the front side is sent. The order of the output is never actually sent, but rather the output is varied when there is an error and a retransmission.

The Examiner assumed that the order is sent as the Examiner assumes no sorting, but no such teaching is actually made that no sorting is necessary. Rather the background and summary deals with after an error the print is not improperly started on a different side. Therefore, actual collation of the print may still be necessary if printed different than the receiving part receives the paper as such is not taken into account by Yoshida.

3. Yoshida actually does not disclose that controlling a transmission of fax data according to a data output order of a facsimile part because, when re-transmitting, the retransmission always has the front side sent first according to col. 10 of Yoshida. Therefore, the order itself is not varied or affected.

4. With respect to claim 6, the Examiner states that Yoshida teaches said requiring of said document order being made during Phase B of a facsimile transmission.

However, the presence absence of both side reception is not the output order. According to MPEP §2131, the elements must be literally present and exactly as arranged in the claim. The presence or absence of both side reception does not deal with the order, rather it deals with the side of the paper. The printing is still done in Yoshida in the same sequential order. The actual order is not changed, but only that a retransmission resets the front page first printing.

5. With respect to claim 7, the Examiner stated that Yoshida teaches the method of claim 1, with said dialing a predetermined telephone number of said facsimile receiving part being automatic (S84 in fig. 5).

The Examiner stated in paper no. 20050831 that the CKT 26 dials the destination number automatically when receiving a *call command pulse*. However, col. 3, lines 22-25 states that it is a select signal of DTMF which is sent after a call command pulse. Therefore, this is not automatic but actually manual. Select signal can still be manually given and therefore, there is no exact teaching that it is actually automatic.

The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). Here, is clear by using a circuit alone does not necessarily mean automatic.

III. Claim Rejections - 35 USC § 103

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Yoshida as applied to claim 1 above, and further in view of Ishizuka et al. U.S. Patent No. 5,282,050 (hereinafter Ishizuka). The Applicant respectfully traverses.

1. With respect to claim 2, the Examiner argues that single sided printing and dual sided printing is the order of the print that is displayed. However, as mentioned above, dual sided printing and single sided printing is still printing in the same order and not different, rather its on what side of the page is actually used. Therefore, claim 2 is not obvious.

2. With respect to claim 18, the Examiner stated that Ishizuka, teaches the advance transmitting function by the inquiry key 220 that is selected. However the key is inquiring whether there is dual sided printing or dual sided reading. This again does not necessarily affect the order of the output.

Moreover, such an accommodation is not made when the call is connected as no such teaching on col. 7 of Ishizuka is made.

3. With respect to claims 19 and 20, the Examiner stated that by indicating the capability of dual side or single sided printing capability, it then shows the order it prints. However, again, the actual order of printing would be still in the same sequential order, thereby the order itself is never displayed.

Moreover, identifying does not necessarily mean displaying. One can identify without displaying for a user to see. The identification mentioned is more of a determination rather than

an actual display.

Respectfully, the Examiner is improperly stretching the teaching of the references to accommodate a rejection.

4. Concerning claim 19 and 20, the sequence in which the output order is displayed and the data is transmitted is not taught or suggested. In claim 19, the output order is displayed and then after it is displayed, then the data is transmitted. In claim 20, the displaying of the output order is when the output order is received. However, in Ishizuka, there is only a mention that when there is an identification of the dual side “reading” function and dual side recording function, that there is an instruction made.

B. Claims 13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Ishizuka and in further in view of Bloomfield U.S. Patent No. 6,693,729. The Applicant respectfully traverses.

1. With respect to claim 13, the above arguments apply. In addition, the combination of Yoshida and Ishizuka do not disclose transmitting the stored document data in the same order as the received data output order as seen in the amended claim 13.

C. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida, Ishizuka and Bloomfield as applied to claim 13 above and in further view of Suzuki. The Applicant respectfully traverses.

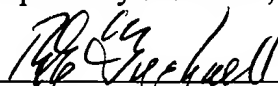
The arguments above apply including claim 13 for which claim 14 depends.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

A fee of \$790.00 is incurred by filing a Request for Continued Examination (RCE), and a fee of \$570.00 is incurred by filing a petition for three-month extension of time. Please note that two-month extension of time fee of \$450.00 has been previously paid on 8 November 2005. ($\$1020.00 - \$450.00 = \$570.00$) Applicant's check drawn to the order of the Commissioner accompanies this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned

attorney in the amount of such fees.

Respectfully submitted,



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